Claims 1, 22 and 31 are amended.

## REMARKS

1.    Applicant thanks Examiners Gilligan and Thomas for their kind assistance, provided during a telephone interview on March 9, 2004.  During the interview, the Examiners reiterated their position that the combination of references upon which the rejection of the Claims under 35 USC §103(a) was based was proper and that the Claims were not allowable over the cited references.  The Examiners agreed that the references, separately or in combination, do not appear to describe a data dictionary as described in the specification of the present application, particularly on page 17.

2.    It should be appreciated that Applicant has elected to amend Claims 1, 22 and 31 solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00).  In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which Applicant considers the invention herein to be entitled.  Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

4.    Claims 1-7 and 22-36 stand rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.  The Examiner finds that there is insufficient antecedent basis for the feature "said at least one service recipient's health care record."  Applicant amends Claims 1, 22 and 31 to describe "a health care record for said at least one service

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recipient." Antecedent basis for the amendment is provided in the specification at page 16, line 14 to line 23. Accordingly, Applicant deems the rejection under 35 USC § 112, second paragraph overcome.

5     3.     Claims 1, 22 and 31 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,301,105 ("Cummings") in view of U.S. Patent No. 5,590,038 ("Pitroda") and further in view of U.S. Patent No. 5,737,539 ("Edelson"). Applicant respectfully disagrees.

10     4.     As described in greater detail below, the combination of Cummings, Pitroda, and Edelson fails to teach all features of the Claimed invention. In view of the deficiencies of the combination of references cited, a finding of obviousness must be based on hindsight. It is impermissible to use hindsight to combine references to derive a finding of obviousness. *In re Zurko*, 111 F.3d 887, 889 (Fed.Cir. 1997) (*"Zurko I"*) quoting *W.L.*

15 *Gore & Assocs., Inc. v. Garlock*, 721 F.2d 1540, 1553 (Fed.Cir. 1983). In *Zurko I*, the rejected application related to a method for improving security in a "trusted" computer system that used "trusted" software code to perform "trusted" commands. The applicant sought to design a secure system that could operate with less-costly untrusted code, as well as with trusted code. The step of obtaining confirmation over a trusted path was

20 the only claimed step not explicit in the prior art. The Board found that the teaching was "inherent or implicit" in the prior art. The CAFC, however, disagreed. Reasoning that neither of the cited references taught, either explicitly or implicitly, the step of obtaining confirmation over a trusted path, the appeals court reversed the Board's finding that the invention was obvious.

In a related case, the CAFC affirmed the holding of *Zurko I*. *In re Zurko*, 258 F.3d 1379, 1386 (Fed.Cir. 2001) (*"Zurko III"*). In response to the Board's contention that the step of obtaining confirmation over a trusted path was "nothing more than good common

5  sense[,]" the CAFC held, "[T]the Board cannot simply reach conclusions based on its own understanding or experience—or on its own assessment of what would be basic knowledge or common sense" in regard to core factual findings in a determination of patentability.

10  5.    BILLING MODULE

The Examiner relies on Col. 5, line 2 to line 8 of Cummings as teaching "a billing module for calculating billing information for a service provided to the at least one individual service recipient." Actually the cited teaching has nothing at all to do with billing. Rather it describes the Claims file 20 of Figure 1. As described, the Claims file

15  serves only a storage function, for "detailed information covering relevant items of interest in ensuring accurate administration of claims in accordance with applicable criteria. Included are items such as those relating to claims histories, claims under review and claims in process." There is no design of a billing function or data used to create such a function.  Thus, there is no teaching or suggestion in Cummings of a

20  billing module for calculating billing information for a service provided to the at least one individual service recipient.

The Examiner submits that medical claims are "[C]learly . . . related to billing information for services provided to service recipients."  Thus, just as in *Zurko III*, where the Board

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concluded that the missing step was "plain commonsense" or "basic knowledge," the Examiner asserts that medical claims and billing are inherently related. In this case, just as in *Zurko III*, the statement has no evidentiary basis.

5    Furthermore, the Examiner registers disagreement with Applicant's "interpretation" of the claims file. However, Applicant's "interpretation" of the claims file is taken *verbatim* from the very teaching in Cummings cited by the Examiner.

## 6.    INSURANCE BENEFITS MODULE

10   The Examiner relies on Col 5, line 53 to line 68 of Cummings as teaching "an insurance benefits module for calculating available insurance benefits for a service provided to the at least one individual service recipient." In fact, what is described is the insurance company file 18, figure 1. Cummings describes a file containing insurance benefit information. Cummings merely describes that "system memory" includes or has access

15   to the data. There is no RAM capability that could maintain such data and there is no means defined within Cummings invention to obtain the data necessary. The mere fact that the system memory has access to the data is insufficient to do any calculation of benefits. Accordingly, there is no teaching in Cummings of an insurance benefits module for calculating available insurance benefits for a service provided to the at least

20   one individual service recipient.

The Examiner contends that it is inherent in the function of an insurance provider to calculate available insurance benefits for an insured. However, as in *Zurko I* and *III*, above, the Examiner has not cited a teaching from the prior art to support his contention

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of inherency. Even if it is inherent that an insurance company calculates benefits for an insured, there is no evidence from figure 1 of Cummings or the accompanying description that the insurance companies 24 have access to the insurance company file 18 to calculate benefits.

## 7.    PAYMENT MODULE

The Examiner relies on col. 3, line 22 to line 26 of Cummings as teaching a payment module, including at least one shared platform service and at least one database managing processes for billing and payment." Again, the Examiner finds that that subject matter of the Claims is inherent to the prior art, stating that " clearly . . . payment . . . must be linked to billing." As above, the Examiner has failed to cite a teaching from the prior art in support of his finding of inherency.

Additionally, the Claim language specifically describes the payment module as including "at least one shared platform service and at least one database managing processes . . . . ." The teaching from Cummings makes brief mention of automated funds transfer, but there is no description of the structural components of a shared platform service and a database, performing the function of managing processes for billing and payment.

## 8.    MEDICAL INSURER MODULE

The Examiner relies on Col 4, line 53 to line 62 as teaching "wherein said medical insurer module includes functions for plan definition, open enrollment marketing features, automated authorization of benefits, automated referrals, and service payment

accounting." Cummings insurance file provides a listing of information such as "identification of covered illnesses and procedures, limits on insurance company payments for various illnesses and procedures, treatments and procedures for which utilization review is required, and treatments and procedures for which second opinions

5    are necessary." There is no teaching whatsoever of open enrollment marketing features, automated authorization of benefits, automated referrals, and service payment accounting.

Again, the Examiner maintains the rejection with a bald assertion that the combination

10   of references teaches features of the Claimed invention without pointing to any specific teaching in the record. Thus, the missing features can only be supplied through the improper use of hindsight, as in *Zurko I* and *III*.

Applicant agrees that the Examiner may not comment on the validity of an issued

15   patent. However in observing that the cited teaching was not enabling to one of ordinary skill, Applicant was pointing out that one of ordinary skill would not be led to make the Claimed invention, even in view of Pitroda and Edelson. Applicant also respectfully points out that, while the Examiner may rely on legal precedent in supplying a rationale for a rejection, the Examiner must explain how the facts of the cited case

20   apply. MPEP § 2144. Here, the Examiner has cited *Atlas Powder Co.*, a case from the chemical arts, without explaining how it applies to the facts in this case.

9.    HEALTH PLAN SPONSOR

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The Examiner relies on Col. 9, line 9 – 25 of Cummings as teaching "wherein said health plan sponsor module includes functions for open enrollment processes, benefit plan information maintenance, and coordination of distribution and activation or deactivation of individuals." Applicant respectfully disagrees. Cummings teaches "the

5    identification of the applicant and the authorization of the applicant to participate in the system as denoted by Is Patient Authorized rectangle 102 . . . If verification by the System reveals that the applicant is not authorized to participate, then an indication thereof is produced. This may take any of a variety of forms such as a visual or audible indication. Such an indication is represented by the rectangle 103 which contains the

10   illustrative message Print "Sorry Not Authorized, Call 1-800-4Health." Thus, Cummings merely teaches a process for determining eligibility. There is no teaching whatsoever of functions for open enrollment processes, benefit plan information maintenance, and coordination of distribution and activation or deactivation of individuals.


15   Again, the Examiner's finding that the cited references describe a health plan sponsor module having the Claimed features relies on improper hindsight. Even though Applicant has shown clearly that the combination of references does not fully describe the Claimed features, the Examiner maintains that it somehow does. Again, this can only be so if the references inherently include the missing features, or that the missing

20   features would be supplied by the knowledge generally available to one of ordinary skill. In either case, the Examiner must provide factual evidence, completely lacking here, in support of his assertion.


10.   HEALTH CARE SERVICE PROVIDER MODULE.

The Examiner relies on Col. 6, line 44 – to Col. 7, line 2 of Cummings as teaching "wherein said health care service provider module includes functions for <u>maintaining service recipient records</u>, diagnosing and treating service recipient ailments, managing service payments, accounting services, and <u>maintaining service provider records, including licensing information, staffing affiliations, organizational ownership information, tax identification information, curriculum vitae of licensed practitioners, as well as information regarding disciplinary actions</u>." In fact, the cited portion of Cummings describes a function of the physician's file, wherein "<u>the physician's file is interrogated, and the system prepares a list of the most likely medical condition corresponding to such symptoms, together with the generally approved and/or recommended treatment protocols</u>" (emphasis added). Accordingly, Cummings describes an interactive diagnostic tool. There is no teaching of <u>maintaining service provider records, including licensing information, staffing affiliations, organizational ownership information, tax identification information, curriculum vitae of licensed practitioners, and well as information regarding disciplinary actions.</u>

Applicant is at a complete loss to understand where the motivation or suggestion to provide the missing features comes from. They can only come from a finding of inherency, or that the missing features would be supplied by the knowledge generally available. In either case, evidence in support of such a finding is completely absent.


11.   HEALTH CARE RESEARCH MODULE

The Examiner relies on Col. 10, line 66 to Col 11 line 10 of Cummings as teaching "wherein said health care research module includes functions for collecting data on said

system for research and analysis of health care issues." Applicant respectfully disagrees. What is actually described is a data entry process wherein test results are entered either manually or in a semi-automated process." There is <u>absolutely no teaching of a module that collects data for research and analysis of health care issues</u>.

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Neither Pitroda nor Edelson bridge the gap between Cummings description of manually keying in lab results and <u>a module that collects data for research and analysis of health care issues</u>. Accordingly, the Examiner falls back on inherency, or the general level of knowledge, without providing evidence in support of his conclusion.

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12. SERVICE SUPPORT MODULE

The Examiner relies on Col. 14, line 39 to line 48 of Cummings as teaching "wherein said service support module includes functions for <u>service parameter maintenance, product support, customer requests, and system maintenance</u>." In fact, the cited portion

15 of Cummings <u>describes a flow diagram of post treatment matters and preventive healthcare measures</u>. Accordingly, there is no teaching in Cummings of a <u>service support module</u> that includes functions for <u>service parameter maintenance, product support, customer requests, and system maintenance</u>. Cummings doesn't even contemplate the need for such system services.

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While Applicant respectfully disagrees with the Examiner's finding, it has amended Claims 1 and 22 to describe the service support module more fully.

13.   While the above remarks have been directed to Claim 1, they apply equally to Claims 22 and 31.   In spite of the above, in the interest of expediting prosecution of the Application, Applicant amends Claims 1 and 22 as follows:

A.   SERVICE SUPPORT MODULE

Although the Examiner incorrectly finds that Cummings teaches a service support module, Applicant amends Claims 1 and 22 to describe the service support module in greater detail.   There is no description in the references, taken separately or in combination of a service support module that:

"supports internal maintenance, product billing functions and enablement for module capabilities, said        service support module comprising a platform of central host shared  processing applications that includes:

database update processing;

applications management;

database management;

a data dictionary;

security management;

a system activity file;

said messaging module; and

central electronic output/archive."

Support for the amendment if provided in the specification at page 58, line 18 to page 59, line 15.

B.   DATA DICTIONARY

Claims 1 and 22 are further amended to provide a fuller description of the data

dictionary. Edelson's data warehouse provides protocol interchange and reformatting

capabilities, however there is no other description in the references, taken separately or

together, of a data dictionary that includes:

5          "field definitions;

           acceptable codes or values  organized in acceptable values tables to

provide a uniform healthcare vocabulary;

           wherein said codes ensure data integrity throughout a data value chain

and ensure the data's universal consistency;

10          edit rules;

           format rules;

           identification of a field's data owner, wherein the owner has ultimate

authority for issuing updates and revisions to the field;

           references to diagnostic, procedural, pharmaceutical and personal

15         information codes for use in processing changes to databases and in

construction of research requests to identify potential incompatibilities and

problems;

           wherein a database accesses data dictionary codes when responding to a

query so that information retrieved in response to a query is limited to those

20         cases containing no potential incompatibilities or problems."


Support for the amendment is found in the specification at page 17, line 2 to line 22.

Accordingly, Claims 1 and 22 describe subject matter that is patentably distinct from the prior art. Thus, Applicant deems the rejection of Claims 1 and 22 under 35 USC § 103(a) overcome.

14.	Claim 31 has been amended to include an expanded description of the data dictionary, as in Claims 1 and 22. Therefore, the rejection under 35 USC § 103(a) of Claim 31 and all Claims depending therefrom is deemed overcome.

15.	To further assist the Examiner in appreciating the patentable merit of the Claimed invention, Applicant attaches Appendices A – C. The material of the appendices is not to be taken as supplemental or optional but is to be considered an essential part of this Response, as if fully set forth in the main body of said Response. Appendix A provides a detailed explanation of the context diagram presented in Figures 3-9 of the application, using annotations from the specification to distinguish the invention from each of the references. Appendix B provides a table that distinguishes the Claimed features of the invention from the cited references. Finally, Appendix C provides a table comparing the invention as described in the specification with each of the cited references. Applicant respectfully points out that Appendices A – C have been substantially revised from those submitted in the previous response.

## CONCLUSION

In view of the above, the application is deemed to be in allowable condition. Therefore, the Examiner is earnestly requested to withdraw all rejections and allow the application to pass to issue as a U. S. Patent. Should the Examiner have any questions related to the application, he is urged to contact applicant's attorney at the telephone number given below.

Respectfully submitted,

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